

MAY 06 2004

ATTORNEY DOCKET NO.: ECDC-US
CUSTOMER NO.: 36038

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:
M. Seul et al.

Serial No. 09/448,420

Filed: 11/22/1999

For: Color-Encoding and *in-situ*
Interrogation of Matrix-Coupled
Chemical Compounds))
))
) Group Art Unit: 1639

) Examiner: P. Ponnaluri

) I hereby certify that, on the date indicated below, this
) correspondence was sent by fax to the Commissioner for
) Patents, at (703) 872-9306.
))-By: 

Date: 5/6/04

Commissioner for Patents
PO Box 1450
Alexandria VA 22313-1450Supplement to Petition for Examiner to Comply with MPEP 1208(A)(10),
subparts (c)&(e)

Dear Sir:

Applicants filed a petition for the final rejection to be withdrawn and prosecution to be re-opened in this matter, on 4/26/2004 (the "Earlier Petition") and wish to hereby supplement that Earlier Petition with the additional request and information herein. The Commissioner is authorized to charge Deposit Account No. 502088 for any costs or fees due for this petition, or any other costs connected with this matter.

The basis for the Earlier Petition was that the Examiner, in an Answer to Applicants' Appeal Brief, had not complied with MPEP Section 1208(A)(10), subparts (c)&(e), which respectively require:

(c) For each rejection under **35 U.S.C. 102**, the examiner's answer, or single prior action, shall explain why the rejected claims are anticipated or not patentable under **35 U.S.C. 102**, pointing out where ***all of the specific limitations recited in the rejected claims are found in the prior art relied upon in the rejection.*** [emphasis added]

(e) For each rejection under **35 U.S.C. 102** or 103 where there are questions as to how limitations in the claims correspond to features in the prior art even after the examiner complies with the requirements of paragraphs (c) and (d) of this section, ***the examiner shall compare at least one of the rejected claims feature by feature with the prior art relied on in the rejection. The comparison shall align the language of the claim side-by-side with a reference to the specific page, line number, drawing reference number, and quotation from the prior art, as appropriate.*** [emphasis added]

Applicants have pointed out clearly in the Earlier Petition why the requirements of subparts (c) and (e) above have not been met. There is a mere passing reference in the Answer (at page 5, first paragraph) as to how one (and only one) of the three references used to support the 102 rejections (that is, only Boyce et al.), support steps (a) to (e) of the independent claim 129. There is no indication as to how the other two Section 102 references (Still et al. and Dower et al.) support steps (a) to (e) of claim 129, or how Dower et al. sets forth steps (a) to (e) for support of the Section 103 rejection. And, moreover, even with respect to the Examiner's brief statement (at page 5, first paragraph) about how Boyce refer to steps (a) to (e) of claim 129, the Examiner's Answer has nowhere even attempted to explain where or how the limitations in the dependent claims are present in the prior art. Thus, there is no "pointing out where all of the specific

limitations recited in the rejected claims are found in the prior art relied upon in the rejection," as required in subpart (c) of Rule 1208(A)(10).

Applicants have recently filed a Reply Brief, alleging the lack of compliance with subparts (c) and (e) in the Answer. Accordingly, subpart (e) requires that, in response to Applicants' questioning of support, the Examiner:

shall compare at least one of the rejected claims feature by feature with the prior art relied on in the rejection. The comparison shall align the language of the claim side-by-side with a reference to the specific page, line number, drawing reference number, and quotation from the prior art, as appropriate.

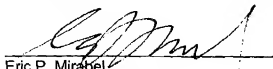
Applicants hereby request, therefore, that the Examiner be required to file a Supplemental Answer, in which subpart (e) is complied with. Of course, in order to file a Supplemental Answer, the Examiner must in fact withdraw the final rejection and re-open prosecution, as Applicants requested in the Earlier Petition. See Rule 1208.03.

Respectfully

Submitted,

Dated: 5/6/2004

By:


Eric P. Mirabel
Registration No. 31,211

Correspondence Address::
Bioarray Solutions
35 Technology Drive
Warren New Jersey 07059
Telephone 908 226 8200 Ext 203
Facsimile: 908 226 0800